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24112	7590	07/01/2004	EXAMINER	
COATS & BENNETT, PLLC			SHAKERI, HADI	
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RALEIGH, NC 27602			PAPER NUMBER	
			3723	

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 10/051,488  
Filing Date: January 18, 2002  
Appellant(s): WILLIAMS, SCOTT G.

MAILED

JUL 01 2004

GROUP 3700

Larry L. Coats  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 08, 2004.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2) ***Related Appeals and Interferences***

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1, 2, 4-16 and 18-24 are pending in this Application.

Claims 1, 2, 4-12, 15, 16 and 18-24 stand rejected over prior art.

Claims 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The rejection of claims 1, 2, 4-7, 10, 15, 16 and 20-23 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 8 and 19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 9 and 18 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 11, 12 and 24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

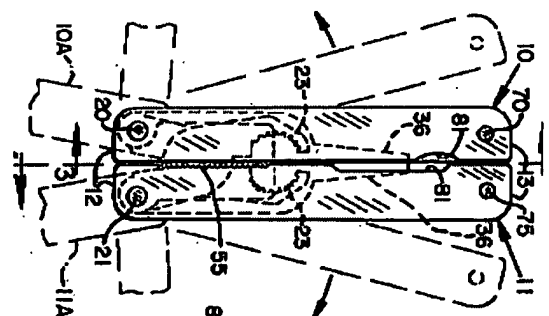
4,238,862	Leatherman	12-1980
1,047,795	Gross et al.	12-1912
5,553,340	Brown, Jr.	09-1996
2,496,840	Alexander	02-1950

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4-7, 10, 15, 16 and 20-23 stand rejected under 35 U.S.C. 102(b) as being anticipated by Leatherman.

Leatherman discloses all the limitations of claims 1 and 15, i.e., a foldable tool, having a plurality of tools comprising a foldable handle movable between a folded position and an open position, a series of tools mounted to the foldable handle

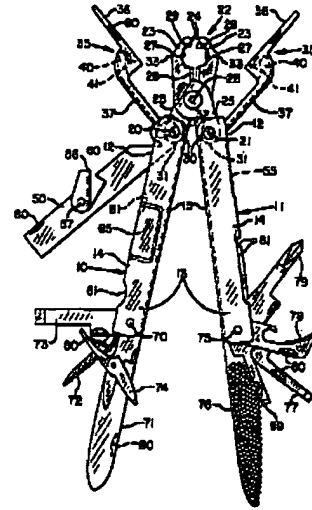


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structure with each tool being movable from a storage position within the handle to an operative position projected outside the handle.

Handles having channel, a wick cutter, i.e., pliers (22) with jaws (23) pivotally connected about a pivot pin (28) with legs connected to the handles. Regarding the narrative and /or functional language, e.g.,

"candle" tool, lacking any structural limitations to define the tool, prior art, e.g., Leatherman is considered to meet the language.



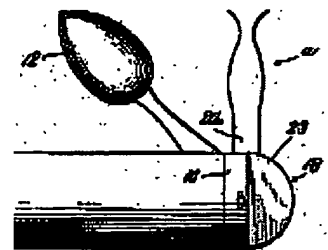
Regarding claims 2-7, 10, 16, 17, 20 and 20-22 Leatherman meets the limitations, e.g., "wick" cutter (22 with cutters 26) or (74), a "wick" dipper, e.g. (73), a "match" holder (35) and candle digger either one of (76) - (80).

Regarding claim 23, an "L-shaped" wick dipper (79).

Claims 8 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman in view of Gross.

Leatherman discloses all the limitations of claim 8, including foldable tools, e.g., (71) (76) which are capable of meeting the function of a "scoop", however,

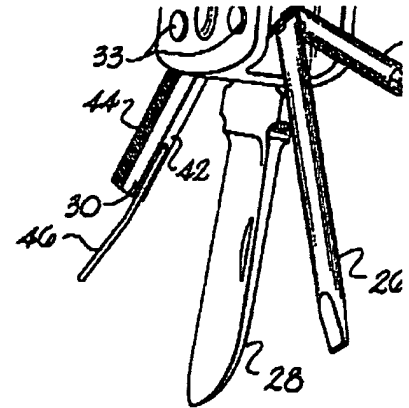
Leatherman does not disclose a tool meeting the accepted terminology of a "scoop", i.e., a rounded or hollow structure. Gross teaches a combination tool having foldable spoon (12). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Leatherman with a foldable tool in form of a spoon as taught by Gross to adapt the combination tool to accommodate various utensils for use at the table.



Regarding claim 19, Leatherman as modified by Gross meets the limitations, i.e., a wick dipper, e.g., (77), an "alligator" clip, (35).

Claims 9 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman in view of Brown, Jr.

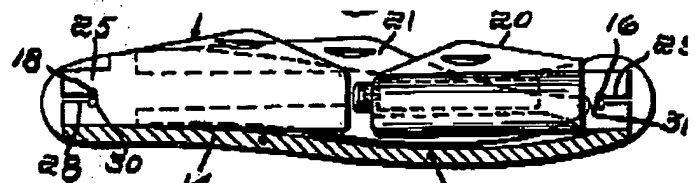
Leatherman discloses all the limitations of claim 9, except for an arm secured to one of the handle and a generally L-shaped wire secured to a terminal end of the arm and extending therefrom. Brown, Jr., teaches a combination tool with an arm, foldable file (44) having wire tool (30). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Leatherman with the file and wire tool as taught by Brown Jr., to adapt the combination tool for cleaning spark plugs and for cleaning hard to reach crevices.



Regarding claim 15, Leatherman as modified by Brown, Jr., meets the limitations.

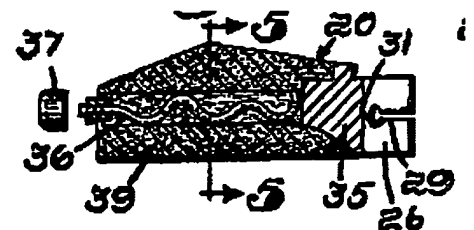
Claims 11, 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman in view of Alexander.

Leatherman discloses all the limitations of claim 11, except for a pre-fueled lighter. Alexander teaches a combination tool with a foldable lighter



(20). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Leatherman with the lighter as taught by Alexander to adapt the combination tool for sportsmen carrying means for igniting a fire.

Regarding claims 12 and 24, Leatherman as modified by Alexander meets the limitations, i.e., the tool including a sleeve (39) including the cavity (36), having an expandable and retractable wick, i.e., the wick (36) can be pulled out or pushed in the sleeve.



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**(11) Response to Argument**

The argument against Leatherman anticipating claims 1 and 15 appears to be that the claims' limitations "candle tools" are not met.

With regards to the argument that the Examiner failed to show each and every element of the claims, i.e., "that only pliers 22 was indicated which even if correct would only meet one of the two candle tools required by the claims' limitations", it is noted that in section 2, of the Final Rejection mailed on July 29, 2003, the Examiner specifically lists the elements in the Leatherman tool considered meeting the claimed limitations, e.g., a "wick cutter (22 with cutter 26) or (74), a wick dipper, e.g., (73), a match holder (35) and candle digger either one of (76-80).

In response to the second point that the Examiner erroneously concluded that lacking any structural limitations to define the tool, prior art is considered to meet the language, and that structural components of the candle tool are defined by the terms, the Examiner agrees only to the point "that is what is at issue in this case". Appellant argues that the Examiner ignored functional connotations of the terms and that Appellant is not aware of any authority that permits the Patent Office to dissect names or terms given structural elements and ignore portions that have functional connotations. Appellant fails to indicate what functional connotations of the terms and/or structural limitations are not met, for example, how does the cutter as indicated in Leatherman, e.g., (26) or (74) not meet the "functional connotations" of a "wick cutter".

Functional connotations of the terms are met by Leatherman since it is capable to perform the function. Therefore contrary to the Appellant's assertion, the Examiner neither dissects the terms nor ignores them.

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In response to the argument that the Examiner refused to even consider or reviewed the Declaration filed on June 06, 2003, the Appellant is in error. The Declaration was considered but it was insufficient to overcome the rejections. It is noted that in the above Declaration, e.g., in section 3, it states that;

"For example, the term wick digger is a term that identifies a particular tool and is understood by those in the art as identifying a candle tool that is used to engage the wick of a candle and to push it down in melted wax around the wick so that to extinguish the wick. These terms set forth above, by their very nature, describe the structure of the particular tool being referred to. When I use these terms in the patent application they are not simply terms that describe a function of any device, but they describe the structure of a particular candle tool."

But the Declaration fails to indicate what these structures are. And as stated in the Office Action, the Declaration does not overcome the 35 USC 102(b) rejection as a matter of law, nor would it overcome the rejection as an issue of fact. The testimony, contrary to the Appellant's statement was not ignored, fails to point out or define structures that would exclude prior art, e.g., Leatherman to read over the claim limitations as recited with their functional connotations, in another words, the tools as disclosed by Leatherman are capable of performing the functions.

The argument regarding infringement is irrelevant, since Appellant disclaiming any interpretation of the candle tool terms that would cover any one of the tools as disclosed by Leatherman does not further limit the claims.

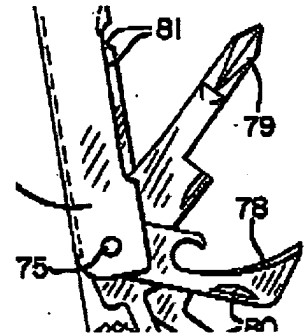
With regards to the inherency argument, it is true that the Examiner did not rely on this doctrine, in the sense of introducing an evidentiary reference disclosing how cutters on a pair of pliers or a pair of scissors can cut a wick, since the cutters as disclosed by the prior art are capable of performing the function.



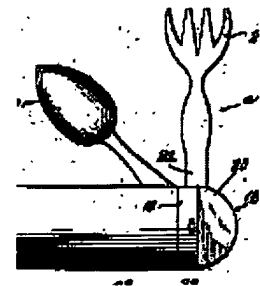
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The argument with respect to claim 15 is in error, since again as indicated above in section 2 of the Office Action, a "wick" dipper, e.g., bit (73), a match holder (35) were clearly indicated.

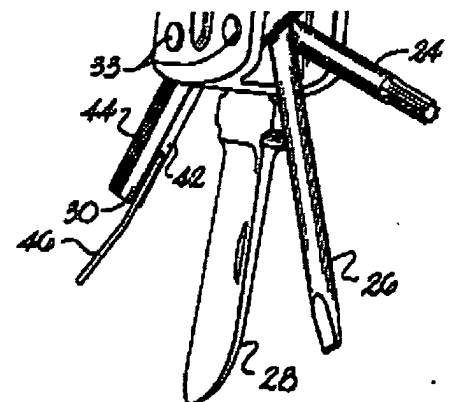
The argument with respect to claim 23 is in error, since nothing in the Declaration establishes how a screw driver cannot meet the limitation of a "wick dipper" since it can perform the function, i.e., dig into the wax. Appellant further argues that the bit (79) is not L-shaped since the extension that holds the bit includes a fingernail grip. It is unclear to the Examiner how the tool foldable in the handle as disclosed (i.e., the tool including the working tip 79 and the extension base) would not be considered "L-shaped", whether or not it includes fingernail grip?



Regarding claim 8, Appellant argues motivation to combine the prior art, since the tools disclosed are not meant to be used as cutleries. Leatherman includes a knife in the foldable tool. Appellant arguments seem to be that it could or should never be used to peel an orange, which is not persuasive, same reasoning applies to modifying the tool to carry a spoon in adapting the tool for use at the tables, e.g., for picnics, camping...

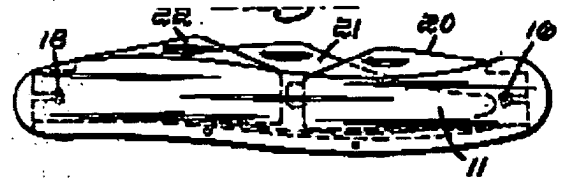


Regarding claims 9 and 18, Appellant argues that the wire tool (30) does not meet the limitations of an L-shape, and that it "simply has a slight bend in it", but this is considered by the Examiner to meet the limitation as recited, i.e., "generally L-shaped wire". With regards to the motivation, Brown Jr., explicitly teaches that the wire device (46) may be used for cleaning hard to reach crevices of a spark plug in a chain saw, clear motivation in adapting the tool of Leatherman for a chain saw.

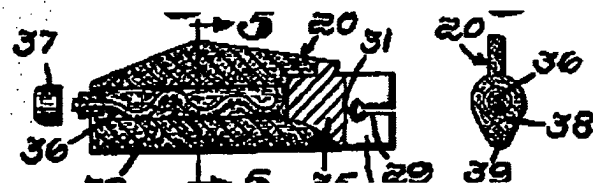


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With regards to claim 11, Appellant again argues the motivation to modify the tool of Leatherman to include a lighter. The Leatherman tool by its very nature is defined as a "pocket multiple tool" and it defines structures and shapes, i.e., foldable tools housed within the handle, with novel arrangement of channel shaped foldable handles housing certain auxiliary tools foldable over pliers jaws for compact carrying and storage and increasing the leverage on the pliers, col. 1, lines 5-63. Leatherman further discloses these certain tools are often needed in situations where it is impractical or at least inconvenient to go prepared with a well equipped tool box. For example hunters, fishermen, campers, bicyclists and ... col. 1, lines 8-18. The patent to Leatherman further goes on to say that "various changes may be made, however, in the details of construction and arrangement, substitution or addition of parts..." obviously it cannot list all possible tools that may be housed in the pocket multiple tool as disclosed, but it clearly discloses tools for "hunters and fisherman and campers". Alexander teaches carrying a pre-fueled lighter for hunters and fisherman, so that when matches become wet it can be used to ignite a fire (col. 1, lines 5-10). There is clear suggestion to combine since the lighter as taught by Alexander is foldable in a similar multiple pocket tool and substituting one of the tools in Leatherman for a lighter as taught by Alexander is well within the knowledge of one of ordinary skill in the art. Thus the suggestion to combine is not hindsight and is not based on the present invention's disclosure, but on the teaching reference.



Claim 12 reciting "...wherein one of the candle tools includes a sleeve having an extendable and retractable wick incorporated therein where the wick functions to light a candle." stands rejected under the combination of the same prior art as with claim



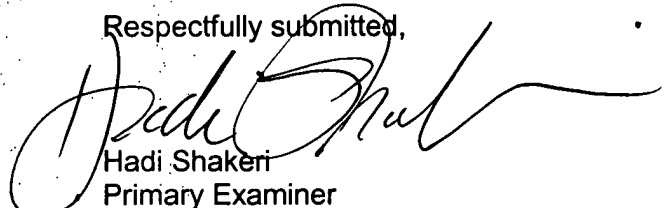
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11, and the limitations are considered met, by the sleeve (38) and the wick which may be pulled or pushed into the cavity (36) to adjust the length exposed.

In conclusion it is noted that the Examiner has not ignored any claim limitations nor the Declaration submitted. The Examiner, per MPEP § 2111, has given the claims their broadest reasonable interpretation consistent with the specification. The Examiner considered it proper to use the specification to interpret what the Appellant meant by a word or phrase recited in the claim, however, did not consider it proper to read limitations appearing in the specification into the claims when these limitations are not recited in the claims, e.g., the specific shape or structure of a "wick cutter". Further, the Examiner found the Declaration to be of little weight in view of specific terms failing to be limited by specific structure in the specification and/or the Declaration.


For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



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HS  
June 22, 2004

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